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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,011	01/29/2004	Vijay Wani	62485B	4735

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THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION
P. O. BOX 1967
MIDLAND, MI 48641-1967

EXAMINER

HUSON, MONICA A

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/767,011	Applicant(s) WANI ET AL.	
	Examiner Monica A. Huson	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/29/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>062504</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Claims 1 - 6, drawn to a molded plastic article, classified in class 428, subclass 40.1.

Claims 7 - 14, drawn to a process for preparing a molded plastic article, classified in class 264, subclass 257.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group II, claims 7 - 14 and Group I, claims 1 - 6 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another materially different process, such as one wherein the molded-on edge covering component is intended to be at the article surface.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Jonathan Morse on October 20, 2005 a provisional election was made with traverse to prosecute the invention of Group II, claims 7 - 14.

Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 1 – 6 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 contains an improper alternative limitation. According to MPEP § 2173.05 (h), alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. A Markush group is an acceptable form of alternative expression and must contain the phrase “selected from the group consisting of A, B and C.” See *Ex parte Markush*, 1925 C.D 126 (Comm’r Pat. 1925). Claim 12 contains the incorrect alternative expression “...semi-rigid sheet material selected from the group of: metal, wood or wood-based paper products...”. In order to correct the claim, the examiner suggests

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rewording the claim as follows: "...semi-rigid sheet material selected from the group consisting of metal, wood, and wood-based paper products...".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Altman et al. (U.S. Patent 5,034,173). Regarding Claim 7, Altman et al., hereafter "Altman," show that it is known to carry out a method for preparing a molded plastic article having a sheet material surface piece (Abstract), comprising the steps of providing a precut sheet material surface piece to a mold cavity (Column 3, lines 64-68); molding in a first molding step a substrate plastic component having the adhered sheet material piece having edges and a surface area (Column 4, lines 9-26); (b) molding on in a second step an edge-covering component which overlaps at least part of the fabric edges and fabric surface area adjacent the edges, but not an area intended to be at the article surface (Column 4, lines 48-65; Column 5, lines 20-48).

Regarding Claim 8, Altman shows the process as claimed as discussed in the rejection of Claim 7 above, including a method where, in the first mold step, the precut sheet material surface piece is adhered in a molding step to a continuous plastic substrate and provided with an edge thickness covering that will cover at least a part of the thickness of the peripheral edges of the sheet material (Column 4, lines 9-26).

Regarding Claim 9, Altman shows the process as claimed as discussed in the rejection of Claim 7 above, including a method where the molded-on edge covering component is provided directly to the substrate plastic component with adhered sheet material that results from the first molding step without intermediate trimming, cutting, or tooling (Column 4, lines 9-26).

Regarding Claim 10, Altman shows the process as claimed as discussed in the rejection of Claim 7, Altman shows the process as claimed as discussed in the rejection of Claim 7, including a method wherein the sheet material is a laminate structure comprising the sheet material, an interior adhesive layer, and on the surface opposite the sheet material layer, a protective backing layer which bonds or otherwise adheres to the substrate plastic and protects the adhesive layer during the molding step (Column 4, lines 4-26; It is noted that it is interpreted that each of these layers would be present in the disclosed laminate structure.).

Regarding Claim 11, Altman shows the process as claimed as discussed in the rejection of Claim 7 above, including a method wherein the second molding step uses a flow leader effect with (a) a main flow leader cavity for the edge-covering plastic component material which main flow cavity is generally around and outside the area of the peripheral fabric edges (Figure 4, elements 14 and 66; Column 4, lines 55-59); and (b) a sheet material edge cavity that receives the flow of the edge-covering material in a direction that is generally not parallel to the peripheral edges of the sheet material (Figure 4, elements 14 and 66; Column 4, lines 55-59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altman, in view of Gardner, Jr. (U.S. Patent 6,753,057). Regarding Claim 12, Altman shows that it is known to carry out a method for preparing a molded plastic article having a sheet material surface piece (Altman) comprising the steps of providing a precut sheet material surface piece to a mold cavity (Column 3, lines 64-68), and in a molding step, molding onto the sheet material a substrate plastic component, wherein the sheet material is a laminate structure comprising a front, surface facing of a thin, semi-rigid sheet material, an interior adhesive layer, and on the surface opposite the sheet material layer, a protective backing layer which bonds or otherwise adheres to the substrate plastic and protects the adhesive layer during the molding step (Column 4, lines 4-26; It is noted that it is interpreted that each of these layers would be present in the disclosed laminate structure.). Altman does not show a specific type of material for his laminate's front layer. Gardner, Jr. show that it is known to carry out a method wherein a laminate structure comprises a front, surface facing of a thin, semi-rigid sheet material selected from the group [consisting] of metal, wood, [and] wood-based paper products (Column 18, lines 22-33). Gardner, Jr. and Altman are combinable because they are concerned with a similar technical field, namely, methods of insert molding panel structures. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Gardner, Jr.'s surface material in the front layer of Altman's laminate structure in order to produce a molded article that accommodates exclusive end-use specifications.

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Regarding Claim 13, Altman shows the process as claimed as discussed in the rejection of Claim 12 above, but he does not show a specific adhesive layer. Gardner, Jr. shows that it is known to carry out a method using a laminate structure wherein the adhesive layer is a polyamide adhesive (Column 9, lines 30-41; Column 10, lines 1-11). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Gardner, Jr.'s adhesive material in the adhesive layer of Altman's laminate structure in order to produce a molded article that accommodates exclusive end-use specifications.

Regarding Claim 14, Altman shows the process as claimed as discussed in the rejection of Claim 12 above, including a method wherein the outer protective backing layer material is the same as or bonds with the substrate plastic (Column 4, lines 4-26), meeting applicant's claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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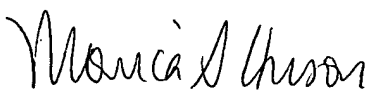
Claims 7 and 12 (and respective dependent claims 8-11, 13 and 14) are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,926,856. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims fully encompass the cited claim of 6,926,856.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Monica A Huson
November 1, 2005


MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER